

REMARKS

Reconsideration is requested.

The Examiner's indication that claims 1-19 are allowable is acknowledged.

Claims 39-43 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description. It is alleged that the recitation "no more than four sidewall surfaces that slope approximately linearly" is not supported in the specification as originally filed.

This rejection is respectfully traversed.

Applicants note that MPEP §2163 states that an applicant may show possession of an invention by disclosure of drawings or structural chemical formulas that are sufficiently detailed to show that applicant was in possession of the claimed invention as a whole. See, e.g., *Vas-Cath*, 935 F.2d at 1565, 19 USPQ2d at 1118 ("drawings alone may provide a 'written description' of an invention as required by Sec. 112"); *In re Wolfensperger*, 302 F.2d 950, 133 USPQ 537 (CCPA 1962) (the drawings of applicant's specification provided sufficient written descriptive support for the claim limitation at issue); *Autogiro Co. of America v. United States*, 384 F.2d 391, 398, 155 USPQ 697, 703 (Ct. Cl. 1967) ("In those instances where a visual representation can flesh out words, drawings may be used in the same manner and with the same limitations as the specification.")

In the instant application, there is adequate support for “no more than four sidewall surfaces that slope approximately linearly” in Fig. 1 since Fig. 1 shows no more than four sidewall surfaces that slope approximately linearly. In addition to Fig. 1, Col. 3, lines 40-47 of the specification, provide a broad, non-limiting description of this feature.

Therefore, the rejection is improper and should be withdrawn.

Claims 44-62, 63-67, 68-72 and 73-101 stand rejected under 35 U.S.C. §251 as attempting to correct an error not within the meaning of the reissue statute. The Examiner has stated that the Federal Circuit has adopted a principle that applicants are estopped from obtaining by reissue claims which, because of a requirement for restriction in which they had acquiesced, they could not claim in their patent. *In re Watkinson*, 900 F.2d. 230, 232, 14 USPQ2d 1407 (Fed. Cir. 1990) is cited.

The Examiner has stated that because Applicants acquiesced to a restriction requirement by deliberately canceling all of the claims not directed to a method of manufacturing a radio frequency device in response to a requirement for restriction, that Applicants right to claim was limited to an elected method of manufacturing a radio frequency device.

The Examiner is taking an overly restrictive view of *In re Watkinson*. Watkinson argued that the error in her original patent was her acquiescence to a restriction requirement in the original application. The court held that there was no error because Watkinson should have challenged the merits of the restriction

requirement in the original application during the prosecution of the original application.

That fact pattern is not applicable to the instant application. Applicants alleged different reasons for error, in Applicants' reissue petition. More particularly, Applicants alleged that the error which resulted in the patent being partially inoperative or invalid includes a failure to claim a method of forming a device that is not necessarily a radio communication device (see Applicants' original reissue declaration).

Watkinson is not applicable.

Further, the fact that Applicants cancelled claims does not mean that Applicants acquiesced to including only claims directed to a method of manufacturing a radio frequency device; instead, Applicants only acquiesced to not include claims directed to the subject matter of the non-elected groups.

The fact that Applicants elected one group, a method of manufacturing a radio frequency device, does not mean that it would not have been possible for Applicants to pursue any apparatus claims at all. In other words, Applicants should not be limited to the elected invention, only estopped from pursuing the inventions defined by non-elected groups that were pending during prosecution of the patent.

More particularly, in the patent, the Office required restriction between the following two groups:

Group I. Claims drawn to a semiconductor device, classified in class 257, subclass 679.

Group II. Claims drawn to a process of making semiconductor device, classified in class 438, subclass 1+.

Thus, Applicants should not be limited to the elected invention, but should only be estopped from pursuing claims drawn to a semiconductor device.

Claims 44-62, 63-67, 68-72 and 73-101 are not directed to a semiconductor device, and are therefore properly includable in this application.

Withdrawal of the rejection under 35 U.S.C. § 251 is requested.

Claims 42, 43, 73, 77, 79, 83, 97, and 100 have been revised to better define the protection that is being sought by Applicants. For example, references to laminating have been removed in some of these claims. Claim 42 has been revised to depend on claim 39, and the last clause of claim 42 has been revised. The last clause of claim 43 has been revised. The last clause in claim 73 has been revised. Claims 77, 79, 83 have been revised. The last clause in claim 97 has been revised. Claim 100 has been revised.

A Statement of Status of Claims and Support in accordance with 37 CFR 1.174(c) is attached as a separate paper.

This application is believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner's next

Appl. No. 10/734,072
Response to 9/8/05 Final Office Action
Atty. Dkt. MI40-369

anticipated action is anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

Dated: Nov. 22, 2005

By: 
Deepak Malhotra
Reg. No. 33,560

Encl.: Statement of Status of Claims and Support



EV550720468

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No.10/734,072
Confirmation No..... 8908
Filing Date December 10, 2003
Inventor Mark E. Tuttle et al.
Patent Number:.....6,329,213 B1
Date Patent Issued: December 11, 2001
Assignee Micron Technology, Inc.
Group Art Unit 2891
Examiner Caridad Everhart
Customer No.021567
Attorney Docket No.....MI40-369
Title: Methods for Forming Integrated Circuits Within Substrates

To: Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

From:Deepak Malhotra (Tel. 509-624-4276; Fax 509-838-3424)
Wells St. John P.S.
601 W. First Avenue, Suite 1300
Spokane, WA 99201-3828

STATEMENT OF STATUS OF CLAIMS AND SUPPORT

Claims 1-18 are from the patent for which a reissue is sought and are now pending.

Claims 19, and 39-101 are added and are now pending.

Support for claim 19 can be found at least in original claim 1, and in Col. 1, lines 12-16 and 59-61, Col. 2, lines 15-21, and Claims 2-5 and 13-18.

Support for claim 39 can be found at least in Col. 1, lines 12-13, Col. 2, lines 2-5, Col. 3, lines 29-32 and 48-51, Col. 4, lines 10-13 and 44-58, Col. 5, lines 29-32, Col. 6, lines 1-4, and Figs. 1 and 4.

Support for claim 40 can be found at least in Col. 4, lines 10-17 and Fig. 1.

Support for claim 41 can be found at least in Col. 5, lines 4-8 and Fig. 1.

Support for claim 42 can be found at least in Col. 4, lines 10-17 and 49-65; and Col. 5, lines 42-50 and Figs. 1 and 7.

Support for claim 43 can be found at least in Col. 6, lines 1-4; and Col. 5, lines 42-50 and Fig. 7, and Col. 5, lines 42-50 and Fig. 1.

Support for claim 44 can be found at least in Col. 1, lines 12-13, Col. 2, lines 2-5, Col. 3, lines 29-32 and 48-51, Col. 4, lines 10-13 and 44-53, Col. 5, lines 29-32, Col. 6, lines 1-4, and Fig. 4.

Support for claim 45 can be found at least in Col. 4, lines 10-17.

Support for claim 46 can be found at least in Col. 5, lines 4-8.

Support for claim 47 can be found at least in Col. 4, lines 31-35.

Support for claim 48 can be found at least in Col 4, lines 53-55, and Col 6, lines 1-4.

Support for claim 49 can be found at least in Col. 4, lines 10-17 and 51-65.

Support for claim 50 can be found at least in Col. 4, lines 10-17 and 49-51.

Support for claim 51 can be found at least in Col. 5, lines 4-8.

Support for claim 52 can be found at least in Col. 4, lines 51-65.

Support for claim 53 can be found at least in Col. 1, lines 12-16, and Col. 6, lines 1-4.

Support for claim 54 can be found at least in Col. 6, lines 1-4.

Support for claim 55 can be found at least in Col. 1, lines 12-13, Col. 2, lines 2-5, Col. 3, lines 29-32 and 48-51, Col. 4, lines 10-13 and 44-65, Col. 5, lines 29-32, Col. 6, lines 1-4, and Col. 4, lines 51-65, and Col. 5, lines 42-50 and Fig. 7.

Support for claim 56 can be found at least in Col. 4, lines 10-17.

Support for claim 57 can be found at least in Col. 5, lines 4-8.

Support for claim 58 can be found at least in Col. 4, lines 44-53.

Support for claim 59 can be found at least in Col. 5, lines 4-8.

Support for claim 60 can be found at least in Col. 4, lines 10-17 and 49-51.

Support for claim 61 can be found at least in Col. 4, lines 51-65.

Support for claim 62 can be found at least in Col. 6, lines 1-4.

Support for claim 63 can be found at least in Col. 1, lines 12-13, Col. 2, lines 2-5, Col. 3, lines 29-32 and 48-51, Col. 4, lines 10-13 and 44-53, and Col. 7, lines 37-44, 54-57, and Fig. 4.

Support for claim 64 can be found at least in Col. 7, lines 54-57.

Support for claim 65 can be found at least in Col. 4, lines 44-53.

Support for claim 66 can be found at least in Col. 4, lines 10-17.

Support for claim 67 can be found at least in Col. 5, lines 4-8.

Support for claim 68 can be found at least in Col. 1, lines 12-13, Col. 2, lines 2-5, Col. 3, lines 29-32 and 48-51, Col. 4, lines 10-17 and 44-65, Col. 5, lines 4-8 and 29-32, and Col. 6, lines 1-4.

Support for claim 69 can be found at least in Col. 5, lines 4-8.

Support for claim 70 can be found at least in Fig. 4.

Support for claim 71 can be found at least in Col. 1, lines 12-16, Col. 5, lines 29-32, and Col. 6, lines 1-4.

Support for claim 72 can be found at least in Col. 6, lines 1-4, and Col. 5, lines 42-50 and Fig. 7.

Support for claim 73 can be found at least in Col. 1, lines 12-13, Col. 2, lines 2-5, Col. 3, lines 29-32 and 48-51, Col. 4, lines 10-13 and 44-53, Col. 5, lines 29-32, Col. 6, lines 1-4, and Fig. 4, and Col. 5, lines 42-50 and Fig. 7.

Support for claim 74 can be found at least in Col. 4, lines 10-17.

Support for claim 75 can be found at least in Col. 5, lines 4-8.

Support for claim 76 can be found at least in Col. 4, lines 31-35.

Support for claim 77 can be found at least in Col 4, lines 53-55, and Col 6, lines 1-4, and Col. 5, lines 42-50 and Fig. 7.

Support for claim 78 can be found at least in Col. 4, lines 10-17 and 51-65.

Support for claim 79 can be found at least in Col. 4, lines 10-17 and 49-51, and Col. 5, lines 42-50 and Fig. 7.

Support for claim 80 can be found at least in Col. 5, lines 4-8.

Support for claim 81 can be found at least in Col. 4, lines 51-65.

Support for claim 82 can be found at least in Col. 1, lines 12-16, and Col. 6, lines 1-4.

Support for claim 83 can be found at least in Col. 6, lines 1-4.

Support for claim 84 can be found at least in Col. 1, lines 12-13, Col. 2, lines 2-5, Col. 3, lines 29-32 and 48-51, Col. 4, lines 10-13 and 44-65, Col. 5, lines 29-32, and Col. 6, lines 1-4

Support for claim 85 can be found at least in Col. 4, lines 10-17.

Support for claim 86 can be found at least in Col. 5, lines 4-8.

Support for claim 87 can be found at least in Col. 4, lines 44-53.

Support for claim 88 can be found at least in Col. 5, lines 4-8.

Support for claim 89 can be found at least in Fig. 4.

Support for claim 90 can be found at least in Col. 1, lines 12-16, Col. 5, lines 29-32, and Col. 6, lines 1-4.

Support for claim 91 can be found at least in Col. 6, lines 1-4.

Support for claim 92 can be found at least in Col. 1, lines 12-13, Col. 2, lines 2-5, Col. 3, lines 29-32 and 48-51, Col. 4, lines 10-13 and 44-53, Col. 7, lines 37-44 and 54-57, and Fig. 4.

Support for claim 93 can be found at least in Col. 7, lines 54-57, and Col. 7, lines 55-57.

Support for claim 94 can be found at least in Col. 4, lines 44-53, and Col. 7, lines 55-57.

Support for claim 95 can be found at least in Col. 4, lines 10-17.

Support for claim 96 can be found at least in Col. 5, lines 4-8.

Support for claim 97 can be found at least in Col. 1, lines 12-13, Col. 2, lines 2-5, Col. 3, lines 29-32 and 48-51, Col. 4, lines 10-17 and 44-65, Col. 5, lines 4-8 and 29-32, and Col. 6, lines 1-4, and Col. 5, lines 42-50 and Fig. 7.

Support for claim 98 can be found at least in Col. 5, lines 4-8.

Support for claim 99 can be found at least in Col. 4, lines 10-17 and 49-51.


Support for claim 100 can be found at least in Col. 1, lines 12-16, Col. 5, lines 29-32, and Col. 6, lines 1-4.

Support for claim 101 can be found at least in Col. 6, lines 1-4.

Appl. No. 10/734,072
Statement of Status of Claims and Support
Atty. Dkt. MI40-369

Respectfully submitted,

Dated: Nov 22, 2005

By: 
Deepak Malhotra, Reg. No. 33,560